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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,976	04/28/2006	Thomas Rueckle	283829US0PCT	9518

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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
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ALEXANDRIA, VA 22314

EXAMINER

HAVLIN, ROBERT H

ART UNIT	PAPER NUMBER
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1626

NOTIFICATION DATE	DELIVERY MODE
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09/20/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/565,976	Applicant(s) RUECKLE ET AL.	
	Examiner ROBERT HAVLIN	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 3,6,9,10,12-20 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,11 and 21 is/are rejected.
- 7) ☒ Claim(s) 7 and 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

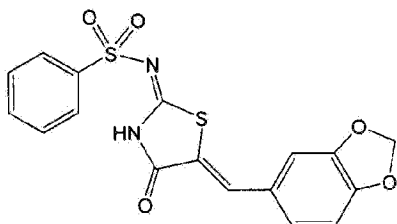
DETAILED ACTION

Status of the claims: Claims 1-22 are currently pending.

Priority: This application is a 371 of PCT/EP04/51625 (07/27/2004) and claims priority to EUROPEAN PATENT OFFICE (EPO) 03102313.8 (07/28/2003).

Election/Restrictions

1. Applicant previously elected Group I (claims 1-11 and 21) and the following species (allegedly reading on claims 1, 2, 4, 5, 7, 8, 11, and 21):



As detailed in the following rejections, the generic claim encompassing the elected species was not found patentable. Therefore, the provisional election of species is given effect, the examination is restricted to the elected species only, and claims not reading on the elected species are held withdrawn. Accordingly, claims 3, 6, 9, and 10 are hereby withdrawn.

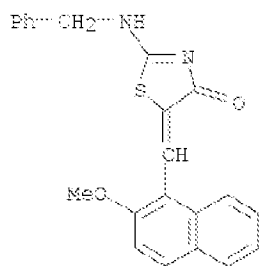
Should applicant, in response to this rejection of the Markush-type claim, overcome the rejection through amendment, the amended Markush-type claim will be reexamined to the extent necessary to determine patentability of the Markush-type claim. See MPEP 803.02.

RESPONSE TO APPLICANT REMARKS

Claim Rejections - 35 USC § 102

2. Claims 1, 4, 11, and 21 were rejected under 35 U.S.C. 102(b) as being anticipated by Vasa et al. (CAPLUS Abstract of: Journal of the Indian Chemical Society (1959), 36, 648-50).

The prior art teaches the following compound prepared as a pharmaceutical



which reads on the instant claims when:

X is S, Y is O, G is unsubstituted alkyl-aryl, R1 is C1-6-alkoxy, R2 is H, and A is a 6-membered aryl.

Applicant correctly points out that the point of attachment on the naphthyl group differs from the scope of the instant claims. Therefore, this rejection is **withdrawn**.

NEW CLAIM REJECTIONS

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 2, 4, 5, 11, and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims define "sulfonyl moiety" as an alternative for "G" without providing a clear and unambiguous definition. The specification describes exemplary embodiments of a "sulfonyl moiety":

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In particular, G is selected from the group comprising or consisting of an optionally substituted sulfonyl moiety, including phenyl sulfonyl, 4-methylphenyl sulfonyl, methyl sulfonyl, ethyl sulfonyl, 6-chloropyridine-3-sulfonyl, thiophene-2-carboxylic acid methyl ester-3-sulfonyl, 5-chloro-1,3-dimethyl-1H-pyrazole-4 sulfonyl, 3-chlorophenyl sulfonyl, 2-chlorophenyl sulfonyl, quinoline-8-sulfonyl, biphenyl-2-sulfonyl, pyridine-3-sulfonyl;

Based the language of the claims and the written description, one of skill in the art would not know what the metes and bounds of the claims are – it could be a -S(O)₂-H group, an -S(O)₂-anything group, or an anything-S(O)₂-anything group.

The Board of Patent Appeals recently clarified the appropriate standard the USPTO applies when evaluating whether a claim satisfies the 35 USC § 112, second paragraph requirement when a claim presents two or more plausible claim constructions:

The Federal Circuit has held in post-issuance patent infringement cases that the definiteness requirement “does not compel absolute clarity” and “[o]nly claims ‘not amenable to construction’ or ‘insolubly ambiguous’ are indefinite” *Datamize, LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 1347 (Fed. Cir. 2005) (citations omitted). See also *StarScientific, Inc. v. R.J. Reynolds Tobacco Co.*, Appeal No. 07-1448, slip. op. at 22 (Fed. Cir. August 25, 2008) (“A claim term is not indefinite just because ‘it poses a difficult issue of claim construction,’” (quoting *Exxon Research & Eng’g Co. v. United States*, 265 F.3d 1371, 1375 (Fed. Cir. 2001))). The Federal Circuit has noted that such a high standard of ambiguity for finding indefiniteness is due to the statutory presumption of patent validity. *Exxon Research*, 265 F.3d at 1375 (“By finding claims indefinite only if reasonable efforts at claim construction prove futile, we accord respect to the statutory presumption of patent validity.”) See also *Modine Mfg. Co. v. U.S. Int’l Trade Comm’n*, 75 F.3d 1545, 1557 (Fed. Cir. 1996) (rejecting indefiniteness argument after construing claims; stating that “when claims are amenable to more than one construction, they should when reasonably possible be interpreted to preserve their validity”); and *Athletic Alternatives, Inc. v. Prince Mfg., Inc.*, 73 F.3d 1573, 1581 (Fed. Cir. 1996) (court chose the narrower of two equally plausible claim constructions in order to avoid invalidating the claims).

This rule of reading claims narrowly in view of ambiguity runs counter to the USPTO’s broader standard for claim construction during prosecution. In particular, unlike in post-issuance claim construction, the USPTO gives

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pending claims “their broadest reasonable interpretation consistent with the specification” and “in light of the specification as it would be interpreted by one of ordinary skill in the art.” *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). This broader claim construction standard is justified because, during prosecution, the applicant has the opportunity to amend the claims, and the Federal Circuit has held that an applicant has the opportunity and the obligation to define his or her invention precisely during proceedings before the USPTO. *See In re Morris*, 127 F.3d 1048, 1056-57 (Fed. Cir. 1997) (35 U.S.C. 112, second paragraph, places the burden of precise claim drafting on the applicant); *In re Zletz*, 893 F.2d 319, 322 (Fed. Cir. 1989) (manner of claim interpretation that is used by courts in litigation is not the manner of claim interpretation that is applicable during prosecution of a pending application before the USPTO).

...

As such, we employ a lower threshold of ambiguity when reviewing a pending claim for indefiniteness than those used by post-issuance reviewing courts. In particular, rather than requiring that the claims are insolubly ambiguous, we hold that if a claim is amenable to two or more plausible claim constructions, the USPTO is justified in requiring the applicant to more precisely define the metes and bounds of the claimed invention by holding the claim unpatentable under 35 U.S.C. § 112, second paragraph, as indefinite.

The USPTO, as the sole agency vested with the authority to grant exclusionary rights to inventors for patentable inventions, has a duty to guard the public against patents of ambiguous and vague scope. Such patents exact a cost on society due to their ambiguity that is not commensurate with the benefit that the public gains from disclosure of the invention. The USPTO is justified in using a lower threshold showing of ambiguity to support a finding of indefiniteness under 35 U.S.C. § 112, second paragraph, because the applicant has an opportunity and a duty to amend the claims during prosecution to more clearly and precisely define the metes and bounds of the claimed invention and to more clearly and precisely put the public on notice of the scope of the patent.

Ex parte Miyazaki, No. 2007-3300, 2008 WL 5105055 (Bd. Pat. App. & Inter.) (Nov. 19, 2008) (precedential opinion, emphasis added).

In the instant case, the claims have two or more plausible claim constructions that render the claims indefinite. The examiner recommends incorporating a specific definition into the claims to resolve the ambiguity.

Claim Rejections - 35 USC § 102

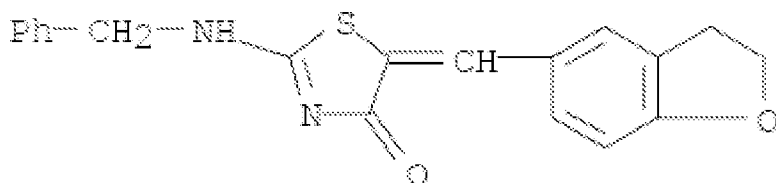
5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 4, 11, and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Hasegawa et al. (US 2006/0293338).

Hasegawa teaches the following compound as a pharmaceutical agent:



example 66 on page 26 (on

page 46 of priority doc 60/428384, filed 11/22/02); this species anticipates the instant claims when:

A is 2,3-dihydro-furanyl,

X is S,

Y is O,

G is -CH₂-Ph (C1-alkyl aryl).

Claim Objections

Claims 7, and 8 are objected to for being dependent on a rejected base claim and reading on subject matter beyond the restricted scope.

Conclusion

The claims are not in condition for allowance.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT HAVLIN whose telephone number is (571)272-9066. The examiner can normally be reached on Mon. - Fri., 7:30am-5pm EST.

If attempts to reach the examiner by telephone are unsuccessful the examiner's supervisor, Joe McKane can be reached at (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert Havlin/
Examiner, Art Unit 1626